

REMARKS

Applicant hereby adds new claims 28-36. Accordingly, claims 1-36 are pending in the present application.

Claims 2 and 3 stand rejected under 35 USC 112, second paragraph, for indefiniteness. Claims 10 and 23 are objected to. Claims 1-27 are rejected under the judicially created doctrine of obviousness-type double patenting. Claims 1, 6, 8, 13, 15, 19, 21, and 26 stand rejected under 35 USC 103(a) for obviousness over U.S. Patent No. 6,101,407 to Groezinger et al. in view of U.S. Patent No. 5,956,487 to Venkatraman et al. and U.S. Patent No. 6,115,737 to Ely et al. Claims 2-3, 5, 7, 9, 12, 14, 16-17, 20, 22, 25, and 27 stand rejected under 35 USC 103(a) for obviousness over Groezinger in view of Venkatraman and Ely and further in view of E.P.O. Patent No. EPO000843268A2 to Danknick et al. Claims 4, 10-11, 18, and 23-24 stand rejected under 35 USC 103(a) for obviousness over Groezinger, Venkatraman, Ely and Danknick and further in view of E.P.O. Patent No. EP 1003307 A2 to Motoyama.

Applicant respectfully traverses the rejections and urges allowance of the present application.

Referring to the indefiniteness rejections, Applicant has amended claims 2 and 3 as indicated herein. Claims 2 and 3 are believed to be definite and understood by one of ordinary skill in the art. The amendments of claims 2 and 3 made herein now more positively express limitations which were previously inherent in such claim(s), and accordingly are not for the purpose of narrowing and do not effectively narrow the scope of any claim.

Referring to the double patenting objection to claims 10 and 23, claims 10 and 23 have been amended as indicated above. Applicant respectfully requests withdrawal of the double patenting objection to claims 10 and 23.

Referring to the obviousness double patenting rejection of claims 1-27, Applicant submits a terminal disclaimer with respect to Application No. 09/976,642. Applicant requests withdrawal of the obviousness double patenting rejection for at least this reason.

Turning to the rejections of the claims over the prior art, Applicant notes that to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references

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themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See, e.g., MPEP §2143 (8<sup>th</sup> ed., rev. 2).

Applicant respectfully submits that the Office has failed to establish prima facie 103 rejections of the claims and the pending claims are allowable for at least this reason.

More specifically, referring to claim 1, the Office on page 5 of the Action states that Groezinger fails to disclose limitations of claim 1 and apparently relies upon the teachings of two secondary references Venkatraman and Ely in support of the rejection.

The Office at page 5 states that the motivation for the combination is to be able to carry out the configuration of the imager via the client on a TCP/IP via a URL associated with a hot link that is activated by the user to access the associated embedded web browser. However, as opposed to setting forth a proper *motivation* for one to combine the reference teachings, the Office merely sets forth the results if the references are modified and not requisite motivation to support the combination in the first instance. Preferably, the Examiner's explanation should be such that it provides that impetus necessary to cause one skilled in the art to combine the teachings of the references to make the proposed modification. *Ex Parte Levengood*, 28 USPQ2d, 1300, 1301, Footnote 2, (Bd. Pat. App. and Inter. 1993). Inasmuch as the alleged motivation provided by the Office is merely the results if the references are combined, there is no impetus to motivate the combination of the references and the Office has failed to establish a proper 103 rejection for at least this reason.

There are additional reasons that one of skill in the art that would not combine the references in the manner proposed by the Office. First, Groezinger already provides teachings to access the imager remotely using a client machine 40 not using a hotlink. For example, at col. 4, lines 40-67, it is stated that a technician may access the imager 30 to select conversion operations provided upon received image data. Client machine 40 may execute TCP/IP and file transport protocol communications over communications link 48 with the imager 30.

Accordingly, the teachings of the secondary references are redundant to the teachings of Groezinger and one would not be motivated to combine the reference teachings in view of the redundancy. More specifically, Groezinger already provides remote configurations and there is no motivation to alter the remote configuration of Groezinger to arrive at Applicant's method of claim 1. Why would one aware of the teachings of Groezinger look to the secondary references for teachings directed to the subject matter already disclosed in Groezinger? The answer in view of the lack of any supporting objective evidence is the motivation can only result from improper reliance upon Applicant's disclosure. The motivation for forming the combination must be something other than hindsight reconstruction based on using Applicant's invention as a road map for such a combination. *See, e.g., Interconnect Planning Corp. v. Feil*, 227 USPQ 543, 551 (Fed. Cir. 1985); *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990). The 103 rejection of claim 1 is improper for at least this reason and Applicant respectfully requests allowance of claim 1 in the next Action.

As mentioned by the Office, Groezinger does not disclose utilization of a hot link to configure the imager. It is taught in Groezinger that a technician may command the imager 30 to generate an HTML document from client machine 40. In addition, as set forth in col. 5, lines 1-19, it is stated that the document may include hypertext links for the purpose of accessing input images stored by the imager 30. The accessing of images stored within the imager 40 fails to disclose or suggest any configuration of the imager. Further, the explicit teachings of Groezinger illustrate that the inventors of the Groezinger reference have already considered and implemented hypertext links for limited purposes and decided not to use hypertext links for configuration of the imager.

Additionally, inasmuch as there is no evidence of record that the disclosed system of Groezinger is deficient with respect to its implementation of remote configuration aspects or that any improvements would result from the modification proposed by the Office, there is no legally sufficient motivation to combine the numerous references as alleged by the Office. Groezinger was aware of the existence and usage of hypertext links by the usage thereof to access images and the inventors of Groezinger decided not to use hypertext links to implement configuration operations with respect to the imager itself. The Office has failed to

present any evidence of record to support the combination contrary to the explicit teachings of Groeziner and the Office has failed to establish a proper prima facie 103 rejection for at least this reason.

More specifically, the Federal Circuit discussed proper motivation *In re Lee*, 61 USPQ 2d 1430 (Fed. Cir. 2002) and required that *motivation be based upon objective evidence of record*. The motivation identified in the Office Action is akin to the conclusory statements set forth in *In re Lee* which were found to fail to provide the requisite motivation to support an obviousness rejection. The Court in *In re Lee* stated the factual inquiry whether to combine references must be *thorough and searching* and it must be based *on objective evidence of record*. The Court in *In re Fritch*, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992) stated motivation is provided only by showing some *objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art* would lead that individual to combine the relevant teachings of the references. The *Lee* Court stated that the Examiner's *conclusory statements* in the *Lee* case do not adequately address the issue of motivation to combine. The Court additionally stated that the factual question of motivation is material to patentability and *can not be resolved on subjective belief and unknown authority. The Court also stated that deficiencies of cited references cannot be remedied by general conclusions about what is basic knowledge or common sense. The Court further stated that the determination of patentability must be based on evidence.*

In the instant case, *the record is entirely devoid of any evidence to support motivation to combine the teachings apart from the bald conclusory statements of the Examiner which are insufficient for proper motivation* as set forth by the Federal Circuit. As demonstrated above, the motivation presented by the Office is merely the *result* of the arrangement of the combination and fails to provide any objective evidence or record to motivate one to make the proposed modification to Groezinger. The Office cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims but must set forth objective rationale upon which it relied. In particular, there is absolutely *no evidence of record to support the rejection*. Groezinger already provides an operable arrangement for configuring the imager and also uses hypertext links for purposes other than configuration of the imager. The only motivation presented in the Office

Action are based upon *the Examiner's subjective belief or unknown authority which is insufficient as clearly held by the applicable authority*. There is no sufficient motivation, the Office Action has failed to establish a prima facie case of obviousness and accordingly the 103 rejection is improper.

The claims which depend from independent claim 1 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

For example, referring to claim 2, the method recites the configuring comprises *determining user thresholds for consumables associated with the hard copy output engine*. The Office states on page 6 of the Action that Groezinger, Venkatraman and Ely are void of disclosing determining of thresholds and relies upon the teachings of Danknick to cure the deficiencies. Applicant respectfully submits that the 103 rejection of claim 2 is improper.

More specifically, it is stated that the further modification to include the teachings of Danknick are appropriate to allow for the ability to perform remote and automated threshold servicing based upon the make and model of the network device as set forth on pages 6-7 of the Action. However, at col. 5, lines 40-50 of Groezinger, remote monitoring is provided by web server 38 of imager 30 generating an HTML document to include various operating statistics (e.g., number of imaging elements used) and based upon the statistics communicated from imager 30, *client machine 40 determines whether a service call is needed or whether new supplies should be sent*. Accordingly, Groezinger already discloses a method of remote servicing wherein the client machine 40 determines whether service or resupply is needed based upon statistics provided by the imager 30. There is no disclosure or need of the imager 30 storing or having a threshold inasmuch as the client machine 40 determines whether service is necessary. There is no *evidence of record* of motivation to modify the Groezinger teachings wherein imager 30 utilizes thresholds or to remotely determine the thresholds of the imager 30 since the machine 40 itself is already configured to make the determination when service or resupply is appropriate.

The motivational rationale recited on page 7 of the Action is redundant inasmuch as Groezinger already discloses remote monitoring and servicing. The

103 rejection is improper for at least this and the above-mentioned reason.

Further, with respect to the embodiment of Fig. 2 of Groezinger, client machine 140 is arranged to communicate with plural imagers 130<sub>1</sub>-130<sub>M</sub>. There is no motivation to lead one to modify Groezinger to determine a make and model using a hot link as claimed instead of other possible alternatives (e.g., the individual devices 130 providing make and model information on their own similar to the disclosed aspects of communicating service information to client machine 140). The only motivation for the modification results from improper reliance upon Applicant's disclosure and the 103 rejection of claim 2 is improper for at least this additional reason.

Referring to claim 3, on page 6 of the Action, it is recited that Groezinger, Venkatraman and Ely are void of sending electronic messages and the Action relies upon the teachings of Danknick in support of the rejection of claim 3. However, even if the numerous disparate references are combined, the combination fails to disclose or suggest positively recited limitations of claim 3 and the Office has failed to establish a prima facie rejection of claim 3 for at least this additional reason.

More specifically, the method recites *sending a first electronic message to a website and receiving a second electronic message including the hot link in response to the first message*. It is stated on page 6 of the Action that web page 19 of Danknick includes a hot link of the printer included at 202. Danknick at col. 13, lines 5-11 states that Fig. 19 illustrating link 202 is a *service request page automatically generated by a network copier in response to a detected condition*. The disclosed service request page responsive to a detected condition fails to disclose or suggest the *second electronic message including a hot link in response to a first message* as claimed. Claim 3 is allowable for at least these compelling reasons.

In the event that a rejection of claim 3 is maintained with respect to the prior art, or a new rejection made, Applicant respectfully requests identification *in a non-final action* of elements which allegedly correspond to limitations of the claims in accordance with 37 C.F.R §1.104(c)(2). In particular, 37 C.F.R §1.104(c)(2) provides that *the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified*. Further, 37 C.F.R. §1.104(c)(2) states that the Examiner must cite the best references at their command. When a

reference is complex or shows or describes inventions other than that claimed by Applicant, the particular teachings relied upon must be designated as nearly as practicable. The pertinence of each reference if not apparent must be clearly explained for each rejected claim specified. Applicant respectfully requests clarification of the rejections with respect to specific references and specific references teachings therein pursuant to 37 C.F.R. §1.104(c)(2) in a non-final Action if claim 3 is not found to be allowable.

Referring to claim 8, there is no motivation to combine the reference teachings in support of the rejection of claim 8 and the 103 rejection is improper for at least this reason. Applicant respectfully requests allowance of claim 8 in the next Action.

The claims which depend from independent claim 8 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 15, the Office has failed to establish a prima facie 103 rejection since there is no motivation to combine the reference teachings in support of the rejection of claim 15 and the 103 rejection is improper for at least this reason. Applicant respectfully requests allowance of claim 15 in the next Action.

The claims which depend from independent claim 15 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 24, there is no motivation to combine the reference teachings in support of the rejection of claim 24 and the 103 rejection is improper for at least this reason. Applicant respectfully requests allowance of claim 24 in the next Action.

The claims which depend from independent claim 24 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Applicant hereby adds new claims 28-36 which are supported at least by Figs. 1, 3 and 6 and the associated specification teachings of the originally-filed

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application.

Applicant respectfully requests allowance of all pending claims.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,

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Date:

3/21/05